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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,625	01/18/2005	Irene Helland	0001742USU	2301

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EXAMINER

RABAGO, ROBERTO

ART UNIT	PAPER NUMBER
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1713

DATE MAILED: 06/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary	Application No.	Applicant(s)	
	10/501,625	HELLAND ET AL.	
	Examiner	Art Unit	
	Roberto Rábago	1713	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 21 and 22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

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DETAILED ACTION

Election/Restrictions

1. Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in reply to this action, to elect a single invention to which the claims must be restricted.

Group I, claim(s) 1-20, drawn to copolymers, films, blends and packaged products.

Group II, claim(s) 21, drawn to process of making a polymer blend.

Group III, claim(s) 22, drawn to process for preparing a film.

The inventions listed as Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical features for the following reasons: the only common feature between the three groups is that polyethylene is required. However, polyethylene is not a special technical feature as defined in PCT rule 13.2 because this feature does not define a contribution over the prior art.

During a telephone conversation with Mr. Paul Greely on 5/31/2005 a provisional election was made with traverse to prosecute the invention of group I, claims 1-20.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 21 and 22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

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Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-4, 7, 8, 14, 15 are rejected under 35 U.S.C. 102(e) as being anticipated by Dekmezian et al. (US 6,734,265).

The reference teaches in claim 1 a polyethylene comprising ethylene and “one or more of propylene, butene-1, pentene-1, hexene-1 or octene-1” made by a process including a bis-indenyl metallocene (claims 3-4), and therefor includes all limitations of composition claims 14 and 15. The reference polymer would appear to be inherently bimodal as required in claim 4 in view of the fact that two distinct metallocenes are used in the production thereof, resulting in two types of polymers. The burden of proof is shifted to applicants to show that the two-metallocene method of making copolymer as

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described in the reference would not provide the bimodal copolymer of claim 4. The remaining limitations of claims 1-3, 7 and 8 would be immediately envisaged by the ordinary skilled worker in this art for the following reasons. Films are the only disclosed use of the disclosed compositions (col. 1, lines 44-51); MWD of ≤ 4.5 or ≤ 3.5 is disclosed in the sentence bridging col. 5-6; molecular weight range of 60k-200k is disclosed at col. 6, lines 1-3.

4. Claims 1-3, 10-12, 14-17 are rejected under 35 U.S.C. 102(b) as being anticipated by Beerwart (US 5,814,413).

The reference discloses in Example 1 the production of a multilayer film comprising one layer which is a blend comprising a low density polyethylene and a three-component terpolymer of ethylene, butene and hexene made using a metallocene single-site catalyst (col. 6, lines 25-44; see also col. 4, lines 12-35). The reference has not disclosed whether the metallocene catalyst used included one or two Cp rings; however, even if the reference copolymers use a mono-Cp metallocene, there is nothing on this record which would indicate that such polymers are outside the broad scope of polymers made using metallocenes having two Cp rings. The following is noted regarding claims drafted as product-by-process (MPEP 2113):

Even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

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The Patent Office bears a lesser burden of proof in making out a case of prima facie obviousness for product-by-process claims because of their peculiar nature" than when a product is claimed in the conventional fashion. In re Fessmann, 489 F.2d 742, 744, 180 USPQ 324, 326 (CCPA 1974). Once the examiner provides a rationale tending to show that the claimed product appears to be the same or similar to that of the prior art, although produced by a different process, the burden shifts to applicant to come forward with evidence establishing an unobvious difference between the claimed product and the prior art product. In re Marosi, 710 F.2d 798, 802, 218 USPQ 289, 292 (Fed. Cir.1983).

The burden is shifted to applicants to show that the reference copolymers are outside the claimed scope regarding the issue of mono/bis Cp metallocene used in polymer production.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 5, 6, 9-11 and 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dekmezian et al. (US 6,734,265).

The parent claims are discussed with respect to this reference above. The reference does not appear to have discussed ranges of comonomer content, and therefore the ordinary skilled worker would look to the working example to obtain a reasonable range of comonomer content. All of the working examples show comonomer content between 4-5 mol%, providing motivation to select a content within

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the claimed range of 0.1-10%. The claimed ranges of density and melt index are among preferred scope of ranges disclosed at col. 5, lines 33-40. Recommendation to blend with another LDPE up to 10 wt% is found at col. 5, lines 17-27. Regarding claims 18-20, official notice is taken that the use of LLDPE film as a packaging material, including for foodstuffs and liquids, is one of the primary commercial uses of such copolymer films, well-known to those of ordinary skill in the art. In sum, one of ordinary skill in the art would be motivated to make polymers and films with the claimed properties because the reference has suggested them as useful alternative embodiments, and would be further motivated to use the disclosed films as packaging materials because commercial and industrial use of the general types of copolymers and films disclosed in the reference as packaging materials is entirely conventional.

7. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dekmezian et al. (US 6,734,265) as applied to claim 1 above, and further in view of Falla et al. (US 20020006482).

Falla discloses multilayer blown films comprising LLDPE using a conventional blow-up ratio of 2.5:1 (see paragraph [0126]). Accordingly, one of ordinary skill in the art would be motivated to use the disclosed film of Dekmezian in a multilayer film because similar LLDPE polymer films have been improved by compounding into a multilayer structure as described in Falla.

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8. Claims 4 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Beerwart (US 5,814,413) as applied to claim 1 above, and further optionally in view of Falla et al. (US 20020006482).

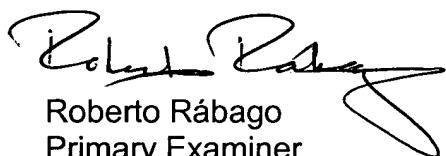
Alternative blend ratios, inclusive of the range required in claim 4, are recited at col. 4, lines 27-35 of Beerwart. Beerwart does not disclose blow-up ratio; however, one of ordinary skill in the art would use conventional values within the range claimed, as disclosed in Falla (see paragraph [0126]). One of ordinary skill in the art would be motivated to use the claimed alternative embodiments because they have been suggested in Beerwart or are conventional, as disclosed in Falla.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Roberto Rábago
Primary Examiner
Art Unit 1713

RR
June 6, 2005